

REMARKS

IDS

A new IDS is submitted.

Amendment

X was missing from before its definition in the specification and in claim 1. It is clear that an error occurred and the correction thereof is also clear in context, as well as in view of the rest of the specification, including the exemplary compounds. The Office Action also interpreted the meaning of X consistent with the amendment.

The Rejections Under 35 USC § 112, first paragraph

Most of the rejections are moot in view of the amendments to the claims.

The Office Action rejects the term “a linear or branched organic radical containing one or more hetero atoms” in the definition of Het, as allegedly lacking written description. The Office Action also rejects the term “a ring containing group –CH₂O–.” This latter term has been further clarified, but the rejection will be addressed in case it is not overcome by the amendment.

The Office Action alleges that the above-identified subject matter is “not defined in the specification so as to known the structure of the compounds that are included and/or excluded.”

Applicants respectfully disagree. One of ordinary skill in the art would clearly understand and be able to identify an organic radical which is linear or branched and contains one or more hetero atoms and a ring structure which contains, e.g., a group –OCH₂O–, and would understand from the description that such groups are described therein, and therefore understand that applicants were in possession of the claimed invention.

The Office Action appears to want specific formulae or otherwise specifically identified structure for each possible group within the definition of the Het or Ar groups. However, there is no general requirement in patent law for such a restriction of an invention.

For example, in the recent decision of the Federal Circuit, *Falkner v. Inglis*, 448 F.3d 1357, 79 USPQ2d 1001 (Fed. Cir. 2006), the invention related to “a way of making vaccines safer by deleting or inactivating an *essential*, rather than an *inessential*, gene from the viral vector's genome.” The approach was taught to be applicable to many different kinds of vector viruses. Detailed description of only the herpes virus was present in the specification, with

pox virus being mentioned. The specification did not identify any *essential* genes in pox virus or describe the inactivation of such *essential* genes. Moreover, the specification specifically admitted that vaccines were not produced with pox virus. The claimed invention was however directed to the making of a vaccine with a pox virus. A written description rejection followed. The Federal Circuit decided that:

[W]e hold, in accordance with our prior case law, that (1) examples are not necessary to support the adequacy of a written description (2) the written description standard may be met (as it is here) even where actual reduction to practice of an invention is absent; and (3) **there is no per se rule that an adequate written description of an invention that involves a biological macromolecule must contain a recitation of known structure.** (Emphasis added.)

Reconsideration is respectfully requested.

The Rejections Under 35 USC § 112, second paragraph, and Claim Objections

Most of the rejections and objections are moot in view of the amendments to the claims.

The Office Action alleges that formula IA in claim 7 is incomplete. Applicants request a clarification for this allegation. All groups are clearly identified in the structure. Thus, formula IA appears complete to applicants.

The Rejections Under 35 USC § 102

This rejection is moot in view of the amendments. The compound of Caramella et al., does not contain a corresponding group to applicants' Het moiety in the claimed compounds.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Csaba Henter/

Csaba Henter, Reg. No. 50,908
Anthony J. Zelano, Reg. No. 27,969
Attorneys for Applicants

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
Arlington Courthouse Plaza 1
2200 Clarendon Boulevard, Suite 1400
Arlington, VA 22201
Telephone: 703-243-6333
Facsimile: 703-243-6410
Attorney Docket No.:MERCK-3073

Date: April 21, 2008

K:\Merck\3000 - 3999\3073\reply Feb 08.doc